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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,306	02/14/2001	Uwe Wenzel	51202	2453

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

KHARE, DEVESH

ART UNIT PAPER NUMBER

1623

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,306

Applicant(s)

WENZEL ET AL.

Examiner

Devesh Khare

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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The request for RCE filed on 08/06/2004, is acknowledged.

The examiner withdraws the prior art references Bezuidenhoudt et al. and Ramabhimaiah et al. applied in the 35 U.S.C. 103(a) rejections of the Final Office action dated 11/04/2003 in response to applicant's remarks that neither Nair et al. nor Yoshikumi et al. suggest the compounds of the formula I or II of the claimed invention.

Claims 1-4 are before the examiner and an action on the merits of said claims is contained herein below.

Minor objections

Claims 1 and 2 are objected to because of the following informalities:

- (1) In claim 1, line 8, the phrase "or" should be replaced by phrase "of".
- (2) The phrases "Hydrogen", "Hydroxy", "Phenyl" and "Methoxy" in all occurrences should be replaced by the phrases "hydrogen", "hydroxyl", "phenyl" and "methoxy".
- (3) In claim 1, line 12, should refer to "phenyl-ring optionally substituted".
- (4) In claim 2, the term "NFxB" should be corrected.

Appropriate correction is required.

35 U.S.C. 112, second paragraph rejection

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) In claim 1, in the absence of the name of a sugar substituent claimed, render the claim indefinite wherein applicant fails to articulate by chemical name or structural formula, requisite to identifying the active substituent of a compound claimed.

(B) Claim 3, is vague and indefinite for stating "inhibiting COX-2 biosynthesis or COX-2 biosynthesis and NF κ B biosynthesis in a patient" as it is unclear what is the therapeutic effect or how is inhibition of COX-2 biosynthesis or COX-2 biosynthesis and NF κ B biosynthesis related to affecting any specific conditions in a patient.

Claims which depend from an indefinite claim which fail to obviate the indefiniteness of the claim from which they depend are also seen to be indefinite and are also rejected for the reasons set forth supra.

2. A review of the prior art revealed no references that could be appropriately applied on claims 1-4 directed to a composition for inhibiting COX-2 biosynthesis or COX-2 biosynthesis and NF κ B biosynthesis comprising a therapeutically effective amount of the compound of formula I or II.

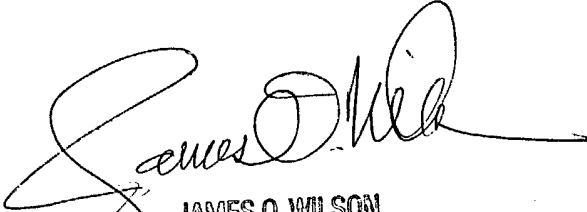
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Devesh Khare whose telephone number is 571-272-0653. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Supervisory Patent Examiner, Art Unit 1623 can be reached at 571-272-0661. The official fax phone numbers for the organization where this application or proceeding is assigned is (703) 308-4556 or 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Devesh Khare, Ph.D., JD.
Art Unit 1623
December 23, 2004



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600